

### III. REMARKS

Claims 1-39 are in the case. Claim 15 has been cancelled; claim 41 has been added; all the other claims have been amended.

#### Claim Rejections - 35 USC 112

Claims 1-39 stand rejected pursuant to 35 USC 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the invention in that the phrase "substituted benzo[b]azepin-2-one compounds of formulae I and II and in each case the tautomers thereof" is confusing as to the intended substituents. The examiner has suggested rephrasing this clause to read "A compound of formula I or II". The claims has been so amended to obviate this ground for rejection.

ii. Claims 1-39 stand rejected pursuant to 35 USC 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the invention in the use of the term "residue". The claims has been amended to replace "residue" with "group" and obviate this ground for rejection.

iii. Claims 1-39 stand rejected pursuant to 35 USC 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the invention in the formation of additional or fused rings formed by  $R^1$ - $R^4$ .

The confusing definition of  $R^1$ ,  $R^2$ ,  $R^3$  and  $R^4$  results from an improper translation of the original German patent application. In the original German application the wording is "... cycloaliphatischen  $C_{3-7}$ -Rest, wobei jeder der vorstehend genannten Reste gegebenenfalls uber eine Etherbrücke gebunden sein kann". A more adequate translation is "... cycloaliphatic  $C_{3-7}$  group, wherein each of the above-stated groups may optionally be bonded via an ether bridge".

Consequently, this definition of  $R^1$ ,  $R^2$ ,  $R^3$  and  $R^4$  encompasses methoxy, ethoxy, propoxy and the like. The corresponding compounds can be made by the inventively claimed process in case a correspondingly substituted compound of formula (I) is used.

The claims have been amended to reflect the proper translation.

iv. Claims 1-39 stand rejected pursuant to 35 USC 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the invention in that  $R^6$  is unclear.  $R^6$  denotes hydrogen or a residue of the formula  $-CH^2-NR^7_2$ , wherein the two residues, are identical or different and have the meaning stated below or may form a 3-8-membered ring together with the nitrogen atom connecting them as a member.

The claims has been amended to delete "residue", and to more clearly define what was meant by residue, thereby obviating this ground for rejection.

v. Claims 1-39 stand rejected pursuant to 35 USC 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the invention in the use of the term "heteroaryl" since the number of rings is not known. The claims has been amended to delete reference to "heteroaryl" and obviate this ground for rejection.

vi. Claims 1-39 stand rejected pursuant to 35 USC 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the invention in that the group Z in ring structures of "X" is unclear. The claims have been amended to recite that Z is "at least one optionally present nitrogen as a ring atom." and obviate this ground for rejection.

vii. Claims 1-39 stand rejected pursuant to 35 USC 112 second paragraph as being indefinite for failing to particularly point

out and distinctly claim the invention in the use of improper Markush language. The claims have been amended into proper Markush form and obviate this ground for rejection.

viii. Claims 2-12 stand rejected pursuant to 35 USC 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the invention in the use of the term "Substituted benzo[b]azepin-2-one compounds and in each case the tautomers thereof according to claim 1". The claims has been amended to delete this phrase and substitute "A compound according to claim 1" and obviate this ground for rejection.

Claims 38-39 stand rejected pursuant to 35 USC 112 second paragraph and 35 USC 101 as being indefinite for failing to particularly point out and distinctly claim the invention and not being proper process claims in that they do not recite any active step. The claims has been so amended to delete "residue" and obviate this ground for rejection.

#### **Claim Rejections - 35 USC 101**

Claims 38-39 stand rejected pursuant to 35 USC 101 as being indefinite for failing to recite any active steps and thus improperly define the method. Applicant has amended the claims to recite active steps and obviate this ground for rejection.

#### **Claim Rejections - 35 USC 112 first paragraph**

Claims 1-37 stand rejected pursuant to 35 USC 112 first paragraph as not being enabling for the scope of compounds claimed in that a large number of compounds are claimed and pharmacological activity is a very unpredictable area, citing In re Fisher.

The Examiner is of the opinion that the scope of the compounds presently claimed is too broad in view of the provided examples.

To overcome the Examiners objection the group X has been amended to be  $X^1$  to  $X^6$  and  $X^{16}$  only.

The remaining groups  $X^1$  to  $X^6$  and  $X^{16}$  represent a cyclohexyl ring that is substituted with a phenyl group. Thus, the factors that influence the pharmacological profile of said compounds e.g. static and electronic factors, are quite similar.

Since all the tested compounds have this moiety in common, and since it has been shown during the pharmacological investigations that all of the compounds are active, it is reasonable to assume that the other-structurally similar compounds show the desired pharmacological activity as well. As only compounds that contain this cyclohexyl-phenyl moiety are within the scope of the amended claim 1, applicant believes that the amended claim 1 is now fully supported by the provided examples.

It is believed this thereby obviates this ground for rejection.

#### **Prospective Claim Objections**

Claims 13-37 are provisionally objected to as being duplicates of claim 12.

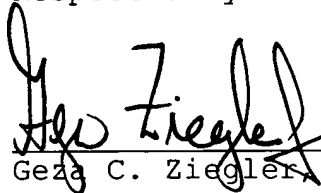
Applicant has amended claims 13-37 to method claims. As it is clear that composition and method claims are of inherently different scope, this amendment should obviate this prospective ground for rejection.

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For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check in the amount of \$450.00 is enclosed for a two-month extension of time. The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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26 April 2005  
Date

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I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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